

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/781,925	02/12/2001	Karen Capers	2001P07466US01

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EXAMINER	
Park, Il Woo	
ART UNIT	PAGE NUMBER
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review ("Request") is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicants respectfully request reconsideration of the rejection of all claims in the Application.

REMARKS

In the prosecution of the present Application, the PTO's rejections and assertions contain clear errors of law. Most notable of the legal errors present in the examination of the Application is a failure of the Non-Final Office Action and the Final Office Action (collectively the "Office Actions") to establish a *prima facie* rejection of the claims in the Application under 35 U.S.C. § 102. The Office Actions rejected Independent Claims 1, 8, 15, and 21 under 35 U.S.C. § 102 as allegedly being anticipated by U.S. Publication No. 2002/0069272, listing Kim, et al. as inventors ("Kim"). However, these rejections fail to meet the required *prima facie* standard for rejections for the reasons set forth below.

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At the outset, Applicants note that this is second pre-appeal brief, involving the same claims and at least one reference. The same claims were previously alleged to be obvious over *Kim* and U.S. Patent No. 6,782,420 issued to Barrett et al., ("*Barrett*"). The PTO presented an obviousness rejection because the PTO acknowledged that *Kim* did not disclose all of the limitations of the independent claims. In the first pre-appeal brief, Applicants successfully established that a *prima facie* case of obvious had not been established using *Kim* and *Barrett*. Now, after the first pre-appeal brief and contrary its previous arguments, the PTO is taking the position that *Kim* discloses each and every limitation. This is incorrect for the below reasons.

Lack of a Prima Facie Disclosure of a First Feature

Independent Claim 1 is allowable because *Kim* fails to disclose, expressly or inherently, "automatically determining that one or more network elements are to be included in the integrated communication server based on the result set." As an alleged disclosure of this feature, the Office Actions pointed to Paragraphs 0038-0040 and 0054. This is incorrect for at least the below three reasons.

First, as discussed above, the PTO has already acknowledged in two previous office actions that *Kim* does not explicitly disclose this limitation. Specifically, in a Non-Final Office Action of July 14, 2005 and a Final Office Action of December 29, 2005, the PTO indicated that "[*Kim*] fails to explicitly disclose step of 'automatically determining that one or more network elements are to be include in the communication server based on the result set', as claimed." In its most recent advisory action as well as the Office Actions, the PTO has not responded to this argument.

Second, the PTO in the Office Actions never identify how *Kim*'s alleged automatic determination is based on a result set that was produced by automatically applying a specified set of rules. Specifically, when the PTO cites *Kim*'s alleged disclose of the above feature, the Office Actions are silent on how the determination is based on the "result set." In Independent Claim 1, the automatic determination is based on the result set, which is (1) produced by automatically applying a specified set of rules, and (2) based on the service option selection and the capacity information. The PTO has noted provided a disclosure of this feature. Additionally,

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in its most recent advisory action, the PTO has not responded to an argument similar to that above.¹

Third, these portions, in fact, do not disclose this feature. Rather, Paragraphs 0038-0040 disclose the latter part of a method of modifying a server configuration. Specifically, Paragraphs 0038-0040 disclose (1) determining whether a user is allowed to modify a parameter, (2) modifying the parameter, (3) communicating the parameter to a server manager, (4) determining tables to update in a database with the modified parameter, (5) updating the tables with the modified parameter, (6) determining which server to synchronize with the updated tables, and (7) attempting to update the configuration of the servers with the modified parameter. The paragraphs preceding Paragraphs 0038-0040 describe an example parameter of increasing a website from 5 megabytes to 10 megabytes. Paragraph 0054 describe a situation in which a website is increased from 10 megabytes to 500 megabytes, requiring another physical server. Clearly, *Kim's* process of synchronizing servers with a database does not disclose automatically determining that one or more network elements are to be included in an integrated communication server based on a result set. For at least this reason, Applicants submit that Independent Claim 1 and its dependents should be allowed. Independent Claims 8, 15, and 21 should be allowed for analogous reasons.

Lack of a *Prima Facie* Disclosure of a Second Feature

Independent Claim 1 is additionally allowable because *Kim* fails to disclose, expressly or inherently, "automatically applying a specified set of rules to produce a result set based on the service option selection and the capacity information." As an alleged disclosure of this feature, the Office Actions previously pointed to Paragraphs 0036 and 0038 for the "specified set of rules" and FIGURE 3 as the result set, but this is incorrect. The display of FIGURE 3 is generated before a user actually modifies a parameter. *See Kim*, Paragraph 0038. Accordingly, the alleged result set of FIGURE 3 cannot be based on the service option selection and the capacity information. It can not be disputed that a thing can not be based upon items not yet in existence.

In response to arguments similar to that above, PTO in its most recent Advisory Action appears to concede that Applicant is correct, alleging for the first time that another "result set" occurs after the selection of items in FIGURE 3. *See* Advisory Action, Page 1. However, in

¹ To this end, Applicants respectfully remind the PTO that "[t]he pertinence of each reference, if not apparent, must

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previous arguments, Applicants anticipated such an argument, indicating "if the PTO alleges that the result set occurs further downstream after a selection of items in FIGURE 3, then Applicants question where *Kim* shows applying a specified set of rules to produce this result set." See Response to Final Office Action, Page 11 (Emphasis Added). The PTO's most recent Advisory Action did not respond to this argument. Applicants submit that the PTO is silent in this regard because *Kim* has no disclosure of applying a specified set of rules to produce this "new" alleged result set. For at least this additional reason, Applicants submit that Independent Claim 1 and its dependents should be allowed. Independent Claims 8, 15, and 21 should be allowed for analogous reasons.

Lack of a Prima Facie Disclosure of a Third Feature

Independent Claim 1 is additionally allowable because *Kim* fails to disclose, expressly or inherently, "automatically determining configuration parameters for the one or more network elements based on the result set." The Office Actions alleged that *Kim* discloses these features at Paragraphs 0040-0041, but this is incorrect. Paragraph 0040 describes attempting to update the configuration of the servers with a modified parameter. Paragraph 0041 describes determining if the server can update itself with the modified parameter. Paragraphs 0040-0041 mention nothing of automatically determining configuration parameters for the one or more network elements based on the result set.

In its most recent Advisory Action, the PTO now for the first time points to other locations of *Kim*, namely Paragraphs 0042 and 0043 as an alleged disclosure of these features. See Advisory Action, Page 1. However, these portions generally describe updating a configuration setting, not automatically determining configuration parameters based on a result set. For at least this additional reason, Applicants submit that Independent Claim 1 and its dependents should be allowed. Independent Claims 8, 15, and 21 should be allowed for analogous reasons.

Lack of a Prima Facie Disclosure of a Fourth Feature

Claim 6 is additionally allowable because *Kim* fails to disclose, expressly or inherently "automatically downloading the network elements from the remote location." As an alleged disclosure of this feature, the Office Actions pointed to Paragraphs 0034, 0054, and 0055, but

be clearly explained and each rejected claim specified." 37 C.F.R. §1.104 (Emphasis added).

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this is incorrect. Paragraphs 0034, 0054, and 0055 mention nothing of downloading network elements, let alone automatically downloading the network elements from a remote location.

In its most Advisory Action, the PTO indicates that "selecting a new server" is downloading a network element. See Advisory Action, Page 1. However, clearly this can not be the case. It can not be disputed that "selecting" is different than "downloading." For at least this additional reason, Applicants submit that Claim 6 should be allowed as should Claims 13, 15, and 21, and their dependents.

CONCLUSION

As a *prima facie* rejection has not been established against Applicants' claims, Applicants respectfully request a finding of allowance of all claims in the Application.

To the extent necessary, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 19-2179 of Siemens Corporation.

Respectfully submitted,



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